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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,004	11/28/2001	Hiroshi Yamada	FUJI 19.210	6947

7590 08/05/2005

Rosenman & Colin LLP
575 Madison Avenue
New York, NY 10022-2585

EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,004

Applicant(s)

YAMADA, HIROSHI

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 1-11 remain for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The defined invention within the claims are more directed to A System For Changing Connection Types Between A Fixed Or Variable State With An External Switching Unit.
3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ©®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for “the” and “said” within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. The first page of the Specification must/shall make reference to PCT/JP99/04075 per 37 C.F.R. 1.78(1).
5. With respect to the applicant's claims to an earlier filing date of 29 July 1999 based on an International Application (PCT/JP99/04075), the following remarks are made:
 - a) such a PCT, or translation, has not yet been submitted, even though stated by the applicant in his 09 May 2005 remarks (pages 12 to 13 (line 2)). The applicant is invited to view the application on <http://portal.uspto.gov/external/portal/pair> by entering 10004004 in the “Enter Number” box followed by pressing the “Enter” key and then clicking the “Image File Wrapper” icon tab (in pale light blue) when the next page appears to see that no such PCT has been submitted [*side bar* the Petition filed 11 February 2005 is in error as it belongs to another application];
 - b) under all the Laws and Rules, the PCT must designate the United States. Without such a copy, in English, it cannot be determined if the United States was so designated;
 - c) the applicant stated that the PCT was filed un 37 C.F.R. 1.53(b). Such 37 C.F.R. 1.53(b) requires meeting the conditions specified in 35 U.S.C. 120, 121 or 365(c) and 37 C.F.R. 1.78(a) (37 C.F.R. 1.78(a) requires the PCT to be complete in

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accordance 37 C.F.R. 1.51(b) (i.e., a specification as prescribed by 35 U.S.C. 112, including a claim or claims, an oath or declaration, drawings, when necessary, prescribed filing fee, exc...)). None of which can be confirmed without a copy of the PCT or translation thereof;

d) 37 C.F.R. 1.53(b) also states, in part, a continuation may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c). 35 U.S.C. 365(c) states in accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language. Such translation to date has not been provided;

c) 35 U.S.C. 365(c) requires the applicant comply with section 35 U.S.C. 120 which states an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application;

d) 35 U.S.C. 120 requires the applicant comply with section 35 U.S.C. 363 which states an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title;

e) 35 U.S.C. 102(e) states an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. There is no indication that PCT/JP99/04075 designated the United States and was published in English;

f) in summary, 37 C.F.R. 1.53(b) invokes 35 U.S.C. 365(c) which invokes 35 U.S.C. 120 which invokes 35 U.S.C. 363 which invokes 35 U.S.C. 102(e) which require the PCT to have designated the United States and have been published in

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English. Without a translated copy of the PCT, all the conditions (at least one inventor, specification per 35 U.S.C. 112, drawing(s), claim(s), designating the United States, published in English, exc..) cannot be judged as met by the applicant.

6. For all the reasons given above, the applicant has not perfected his earlier filing date of 29 July 1999. Thus, the current filings date of 28 November 2001 is considered the effective filing date unless all the conditions cited above in paragraphs 4-5 are met.

7. It should be noted that the PCT, even if designating the United States and published in English on the PCT's most earliest filing date of 29 July 1999, could not be used as a reference against Burns et al. US 6,665,295 B1 because Burns perfected his right to the Foreign Priority Date of 04 December 1998 under 35 U.S.C. 119(a) which states, in part, an application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country. Therefor, any patent granted on this application could not be enforced against Burns, or any users of Burns' invention, making any Patent issued from this application's inoperative against anything akin to Burns disclosure/invention or equivalent(s). Nonetheless, the applicant has not provided a certified English copy of his PCT.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

9. Claims 1-11 are rejected under 35 U.S.C. 102 (a) as being anticipated by Bosloy et al. (CA 2,255,383).

10. Claims 1-11 are rejected under 35 U.S.C. 102 (b) as being anticipated by Bosloy et al. (CA 2,255,383).

11. Claims 1-11 are rejected under 35 U.S.C. 102 (e) as being anticipated by Burns et al. (6,665,295 B1).

12. The only argument the applicant provided was a statement that a copy of the PCT had been filed. None has been so filed to date and thus all Prior Art rejections cited above, and in examiner's prior action, are hereby incorporated in this FINAL Office Action by reference and maintained.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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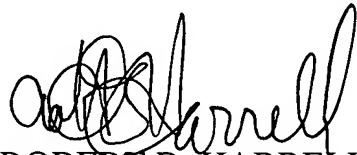
will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'R. B. Harrell', is written over a circular stamp.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142